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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/855,890      | 05/15/2001  | Jeffrey S. Brooks    | BSS 6422            | 1494             |

321 7590 06/18/2003

SENNIGER POWERS LEAVITT AND ROEDEL  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102

EXAMINER

KAVANAUGH, JOHN T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3728

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/855,890

Applicant(s)

BROOKS, JEFFREY S.

Examiner

Ted Kavanaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2001 and 15 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: figures 1-5

Species II: figures 6-9

Species III: figure 10

Species IV: figures 11-12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Donald Teugel (reg. # 45,424) on June 12, 2003 a provisional election was made without traverse to prosecute the invention of Species IV (figures 11-12), claims 1-3,5-10,13,15-17,19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4,11,12,14,18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

3. Claims 1-3,5-10,13,15-17,19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following paragraph is basically repeated from the advisory action in the parent application mailed 2/20/01. It would appear applicant amended the claims with same proposed changes, however no comments were provided about the examiner's comments.

This amendment appears to correct some antecedent basis applied in the parent application 09/379764 but doesn't correct the other indefinite language in the claim and

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the changes also appear to add further confusion to the claims. Applicant has considered all of applicant's remarks in the after final amendment and the discussion from the interview on Feb. 15, 2001 in 09/379764 application. The applicant demonstrated to the examiner how paragraphs a and b of Claim 1 (the other independent claims are similar to claim 1) were to be interpreted. Basically, with regard to paragraph a, "the overall thickness corresponding to the full thickness of the sole and providing a first compressible resilience", was in reference to the total thickness of sole (196) in the heel section, as best shown in figure 7. The thickness as measured by the examiner is roughly 2.4 cm. The sole is basically non-compressible with the exception of the soft foam insert 214 and therefore it was the combination of these two elements together that came up with the "first compressible resilience".

Regarding paragraph b of claim 1, "the overall thickness corresponding to the full thickness of the sole and providing a second compressible resilience", was in reference to the total thickness of sole (196) in the arch section, as best shown in figure 7. The thickness as measured by the examiner is roughly 0.7 cm. The sole is basically non-compressible with the exception of the soft foam insert 214 and therefore it was the combination of these two elements together that came up with the "second compressible resilience". The examiner has taken this all into consideration and reviewed the claims again, with applicant's insight, and has determined that such an interpretation would make the last three lines of claim 1 inaccurate and indefinite since the first region of the forefoot section and the second region of the forefoot section could not possibly have said "first compressive resilience" as found in the heel section and

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said "second compressive resilience" as found in the arch section. The compressive resilience found in the forefoot section has to be different inasmuch as the overall thickness of the sole in this region is roughly 1.3 cm, as measured by the examiner. Therefore the examiner will maintain his 35 USC 112, 2nd paragraph rejection inasmuch as paragraphs a and b contradict paragraph c and therefore one or the other is inaccurate. The other independent claims have similar language and therefore are also indefinite. Note: the elected embodiment as shown in figures 11 and 12 is identical to embodiment shown in figures 7-9 except for the foam insert 214 extends forward under the first phalanges; see page 14, line 26 to page 15, line 2 of the instant specification.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3,5-7,8,13,16,19, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by 1387952 (Steinbrecher).

Steinbrecher teaches an article of footwear substantially as claimed including a second selective compressive resistance greater than the first selective compressive resistance.. The plate 10 represents the second selective compressive resistance since it extends below at least part of the medial section of the arch and heel sections and the

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second region of the forefoot section (metatarsal necks of 2nd and 3rd metatarsal heads). The plate flattens when weight is applied and therefore compresses and is resilient inasmuch as when the weight is removed it springs back into shape or position. Therefore the plate is "compressibly resilient", claim 6. The remainder of the sole represents the first compressive resistance. The plate (10) is resilient and prevents twisting of the sole, see page 2, lines 7-23, and therefore has a greater compressive resistance.

6. Claims 1-3,5-8,13,16,19, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by *US 1557312 (Lelyveld)*.

Lelyveld teaches an article of footwear substantially as claimed including a second selected effective compression resistance greater than the first compression resistance. The plate represents the second selected effective compression resistance since it extends below at least part of the medial section of the arch and the second region of the forefoot section (metatarsal necks of 2nd and 3rd metatarsal heads). The plate flattens when weight is applied and therefore compresses and is resilient inasmuch as when the weight is removed it springs back into shape or position. Therefore the plate is "compressibly resilient", claim 6. The remainder of the sole represents the first resilient portion which extends under the lateral and medial region of the heel section. The plate of Leyland is constructed of steel, see page 1, lines 9-17, and therefore has a greater compression resistance.

7. Claims 1-3,5-8,13,16,19, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by *US 4680877 (Fink)*.

Fink teaches an article of footwear substantially as claimed including a second selected effective compression resistance (7,8) greater than the first compression resistance. Fink teaches soles that extend below the entire foot of different compressions (hardnesses) and therefore each sole extends below the first and second resilient portions as claimed.

8. Claims 1-3,5-8,13,16,19, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by *any of the following references US 4642912 (Wildman et al) or US 4633598 (Moranaga et al) or US 4586273 (Chapnick)*.



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Wildman, Moranaga and Chapnick all teaches a sole for an article of footwear, wherein the sole has a first compressibly resilient portion and a second portion harder than the first portion. All of the reference show the soles have at least two layers of different hardnesses and inasmuch as both layers extend under the entire foot they support every section (i.e. heel, arch, forefoot) on the bottom of the foot and therefore extends below the first and second resilient portions as claimed. All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

9. Claims 1-3,5-8,13,15,16,19, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by US 4506462 (Cavanagh)

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Cavanagh teaches an article of footwear comprising a sole having a first compressibly resilient portion (3) and a second portion (4a,4b,5) harder than the first portion. The soles have at least two layers of different hardnesses and inasmuch as both layers extend under the entire foot they support every section (i.e. heel, arch, forefoot) on the bottom of the foot and therefore extends below the first and second resilient portions as claimed. All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. With regard to claim 15, see figure 2 which shows a boundary line (the ends of 4a and 4b) which appear to extend under the metatarsal necks associated with the first, second and third metatarsal heads.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9-10, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over either *Cavanagh '462* or *US 4642912 (Wildman et al)* or *US 4633598 (Moranaga et al)* or *US 4586273 (Chapnick)*.

*Cavanagh, Wildman, Moranaga and Chapnick* all teach an article of footwear substantially as claimed (see the rejection above for details) except for the specific hardnesses of the first and second resilient portions. It would appear to be an obvious design choice to construct the first and second resilient portions within the range of hardnesses as claimed inasmuch as a number of different hardness appear to be suitable (as long as the second is harder than the first) depending on the individual wearer and the activity being used for. That is, these parameters are recognized in the art to be a variable that is result effective. Generally, it is considered to have been obvious to develop workable or even optimum ranges for such variables. For example, see *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955) and *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Since the applicant has not demonstrated or even alleged that these specifically claimed parameters for the pivoting spine produces unexpected results, it is our conclusion that it would have been obvious for an artisan with ordinary skill to determine a workable or even optimum hardness for the resilient portions as taught by *Cavanagh, Wildman, Moranaga or Chapnick* and thereby arrive at the specific hardnesses claimed by the applicant.

***Double Patenting***

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12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-3,5-10,13,15-16,19 are rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent Nos. 5,787,610 and 5,964,046 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A first resilient material which includes the later region of the heel section and the lateral region of arch section and the first region of the forefoot section. A second harder resilient material which includes the medial region of the arch section and the second region of the forefoot section.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

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### ***Response to Arguments***

14. Applicant's Declaration filed August 15, 2001 has been fully considered but they are not persuasive inasmuch as the claims are indefinite. The claims have been repeatedly rejection as being indefinite (see the prosecution of the parent application). However, the claims continue to be indefinite and therefore since the Declaration refers to language in the claims that has been determined to be indefinite one cannot determine the substance of the Declaration.

### ***Conclusion***

**Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.**

15. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

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If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.

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Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
June 17, 2003